

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant (s): TADYCH, John E.
 Serial No. 10/762,663
 For RUBBER MASKING COMPOUND AND
 METHODS OF USE
 Filed January 22, 2004
 Examiner MULCAHY, Peter D.
 Group Art Unit 1713
 Confirmation No. 5153

CERTIFICATION OF SUBMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted via the Patent Electronic Filing System (EFS) to the U.S. Patent and Trademark Office.

Date: July 08, 2008 John F. Tadych

Mail Stop Appeal Brief – Patents
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Noted PDM 8/8/08

Dear Sirs:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

This reply brief responds to the Examiner's Answer mailed May 28, 2008. The Applicant wishes to briefly address a couple of points raised by the Examiner. First, the Applicant believes that the Examiner has erred in not giving patentable weight to the term "masking compound" as used in the preamble of the claim. The Federal Circuit has stated that

no litmus test can be given with respect to when introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. To say that a preamble is a limitation if it gives "meaning to the claim" may merely state the problem rather than lead one to the answer. The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.

See *Corning Glass Works v. Sumitomo Electric USA*, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

The *Corning* court ruled that the term "optical wave guide" when read in light of the specification requires certain structural dimensions and refractive indexes so that the claim structure functions as an optical wave guide. Therefore, the preamble was considered to be a structural limitation. Similarly, in this case, the term "masking compound" requires the compound to have certain physical properties as known in the art. Consequently, the term "masking compound" is not a mere proposed use but is a term that requires certain characteristics and, as such, should be considered a limitation and given proper patentable weight.

Second, the Examiner states that although the prior art teaches a permanent compound, such a compound is not precluded from use as a masking compound. However, as is well known, a masking compound must be easily removable in a way that does not damage the masked substrate. A permanently attached film would not be easily removable and so the Examiner's conclusions are in error.

For the above reasons, the Applicant believes that the Examiner's arguments presented in the Examiner's Answer do not overcome the arguments presented in the Appeal Brief. Therefore, the Appellant requests that the Examiner's rejections be overruled.

Respectfully submitted,



Alan E. Wagner
Registration No. 45,188

Date: July 28, 2008

P.O. Address:
Whyte Hirschboeck Dudek S.C.
555 East Wells Street, Suite 1900
Milwaukee, WI 53202
Customer No. 22202